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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,808	03/22/2001	Robert Maerz	24294.0003	3108

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EXAMINER

AKINTOLA, OLABODE

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/813,808	MAERZ ET AL.	
	Examiner	Art Unit	
	Olabode Akintola	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/15/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The word “listed” on line 7 of the Abstract should be “listing”.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-48, are rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the claims are directed towards an abstract idea.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to

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be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some “real world” value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Independent claims 1 and 28 each recite a limitation “grouping said pilots into a portfolio and offering said portfolio for investment”. The claim as a whole produces and are limited to grouping said pilots into a portfolio and offering said portfolio for investment. However, “grouping said pilots into a portfolio and offering said portfolio for investment” is abstract idea because grouping and offering is not concrete and tangible. Therefore, claimed invention(s) when viewed as a whole fail to produce a tangible, concrete and useful result and therefore is analyzed as non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29 and 35 are rejected under 35 U.S.C. 112, second paragraph. In particular, the difference between “means for reporting a portfolio investment history” as in claim 29 and

“means for reporting an investment history of a portfolio” as in claim 35 is unclear, since both claims 29 and 35 depend on claim 28.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 11, 13, 19-35, 37 and 40-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Keiser et al. (US Patent 6505174).

With regards to claims 1 and 28, Keiser teaches a method and corresponding system for establishing a product for investment in pilots for television shows and movies, the method comprising: grouping said pilots into a portfolio; and offering said portfolio for investment (see col. 6, line. 43-67; col. 7, line 57-58; col. 10, line. 66-67; col. 11, lines. 1-5).

With regards to claim 2, Keiser teaches the step of grouping said pilots into a portfolio further comprising combining a plurality of pilots (see col. 6, lines 43-67; col. 7, lines 8-12).

With regards to claims 3 and 30, Keiser teaches the step further comprising assigning a rating to a pilot (see col. 7, lines 15-18; col. 17, lines 30-39).

With regards to claims 4 and 32, Keiser teaches the step wherein grouping said pilots into a portfolio is based on a rating value (see col. 7, lines 15-18; col. 17, lines 30-39).

With regards to claims 5 and 33, Keiser teaches the step wherein said rating value is based on whether a network has ordered the pilot (see col. 7, lines 15-18; col. 17, lines 30-39).

With regards to claims 6 and 34, Keiser teaches the step wherein said rating value is based on a pilot history (see col. 17, lines 30-39).

With regards to claims 7, 29 and 35, Keiser teaches the step further comprising reporting an investment history of said portfolio (see col. 17, lines 35-67).

With regards to claim 8, Keiser teaches the step wherein said investment history is reported over the Internet (see col. 17, lines 35-67 and Fig 10).

With regards to claim 9, Keiser teaches the step comprising reporting said investment history by use of a computer to display investment data (see col. 17, lines 35-67 and Fig 10).

With regards to claims 11 and 31, Keiser teaches the step comprising branding said portfolio of pilots (see col. 6, lines 62-64; col. 7, lines 8-12).

With regards to claims 13 and 37, Keiser teaches the step wherein said trade volume is based on an average exchange trading day (see col. 22, lines 25-37).

With regards to claims 19 and 40, Keiser teaches the step of assigning a rating to a pilot further comprises providing a script-talent listing (see col. 6, lines 53-67).

With regards to claims 20 and 41, Keiser teaches the step of assigning a rating to a pilot further comprises calculating a script-talent rating based on a percentage of times a script-talent is listed (see col. 6, lines 53-67, col. 7; lines 1-17, 53-67).

With regards to claims 21 and 42, Keiser teaches the step of conducting a survey of said pilot further comprises determining a production rating (see col. 5, lines 40-50; col. 17, lines 34-46).

With regards to claims 22 and 43, Keiser teaches the step further comprising designating said production rating with a value when a script matures to become one of said pilots (see col. 5, lines 40-50; col. 17, lines 34-46).

With regards to claims 23, 44 and 45, Keiser teaches the step of assigning a rating to a pilot further comprises conducting a mock trading procedure over the Internet for said pilot (see col. 1, lines 49-55).

With regards to claims 24 and 46, Keiser teaches the step of conducting a mock trading procedure generates a rating based on a number of times a pilot is traded (see col. 7, lines 15-18; col. 17, lines 8-12).

With regards to claim 25, Keiser teaches the step further comprising calculating pilot ratings by use of a computer (see col. 7, lines 15-18; col. 17, lines 8-12).

With regards to claim 26, Keiser teaches the step further comprising calculating said pilot ratings by aggregating database of rating inputs (see col. 7, lines 7-23).

With regards to claim 27, Keiser teaches the step further comprising accessing said database of rating inputs via the Internet (see col. 7, lines 7-23).

With regards to claim 47, Keiser teaches the step further comprising a database for aggregating ratings forming said portfolio (see col. 22, lines 1-14).

With regards to claim 48, Keiser teaches the step further comprising a computer for accessing said database via the Internet (see col. 22, lines 1-14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10, 12, 14, 15-18, 36, 38, 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser et al.

With regards to claim 10, Keiser is as discussed above.

Keiser does not explicitly teach the step of reporting an investment by use of a telephone to relay investment data.

However, Keiser teaches the step of establishing an account, by either subscribing online or by telephone (col. 21, lines 61-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Keiser to include the step of reporting said investment by use of a telephone to relay investment data, since Keiser uses a telephone as a tool to relay information to subscribers because it provides the user with an alternative to a computer or the internet.

With regards to claims 12, 14, 15, 16 and 36, Keiser is as discussed above.

Keiser does not explicitly teach conducting a survey of a pilot to determine a trade volume; wherein said survey is conducted over the internet; conducting said survey by use of a computer to aggregate trade volume data; and conducting said by use of any of a telephone, modem or wireless technology to relay trade volume data.

Keiser teaches online market research tool which allows market research users to access information about traders (see col. 5, lines 40-50)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Keiser's online market research tool to include a survey to determine a trade volume as well as aggregate and relay trade volume data in order to provide useful statistical information about the marketability of the pilots thereby enhancing the efficiency of the system.

With regards to claims 17 and 38, Keiser is as discussed above.

Keiser does not explicitly teach the step of conducting a survey of a pilot comprising determining an initial day's rating for said pilot.

Keiser teaches online market research tool which allows market research users to access information about traders (see col. 5, lines 40-50; col. 7, lines 54-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Keiser's online market research tool to include conducting a survey of said pilot comprising determining an initial day's rating for said pilot in order to provide useful statistical information about the marketability of the pilots thereby enhancing the efficiency of the system.

With regards to claims 18 and 39, Keiser is as discussed above.

Keiser does not explicitly teach the step of determining an initial day's rating is based on the first twenty-one (21) days that a pilot is grouped into a portfolio.

Keiser teaches step of determining an initial day's rating based on varying days (1 day, 7 days, 30 days) that a pilot is grouped into a portfolio (see col. 5, lines 40-50; col. 7, lines 54-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Keiser to include the step of determining an initial day's rating based on the first twenty-one (21) days that a pilot is grouped into a portfolio since the applicant's specification does not identify any specific advantage of having an initial day's rating based on the first 21 days that the pilot is grouped into a portfolio.

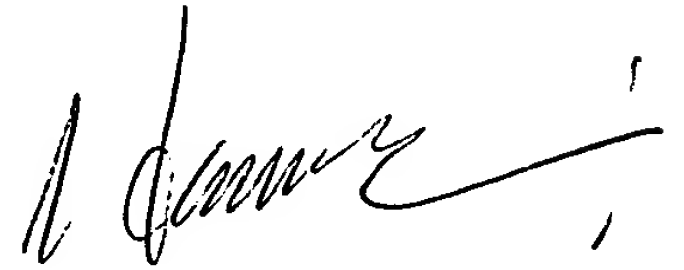
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OA



HANI M. KAZIMI
PRIMARY EXAMINER